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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,804	03/14/2005	Yasuhisa Yamada	XA-10284	2323

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MILES & STOCKBRIDGE PC  
1751 PINNACLE DRIVE  
SUITE 500  
MCLEAN, VA 22102-3833

EXAMINER
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PILKINGTON, JAMES

ART UNIT	PAPER NUMBER
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3682

NOTIFICATION DATE	DELIVERY MODE
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04/18/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/527,804	<b>Applicant(s)</b> YAMADA, YASUHISA	
	<b>Examiner</b> JAMES PILKINGTON	<b>Art Unit</b> 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/14/05, 2/2/07, 7/18/07</u> .                                | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “torque transmitting portion” and “preloading portion.” The Applicant refers to these in the detailed description as grooves and protrusions.

### ***Claim Objections***

2. Claim 17 is objected to because of the following informalities: Line 6 reads “to oppose to” and should be - - opposed to- -. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14-21 and 24-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Duval, USP 6,343,993 (cited by Applicant).

Re clms 14-21 and 24-31, Duval discloses a telescopic shaft in which a male shaft (1) and a female shaft (2) are fitted to each other to be able to transmit torque therebetween and move relative to each other in an axial direction, comprising: a torque transmitting portion (34/35) provided in an outer peripheral portion (34) of said male shaft (1) and in an inner peripheral portion (35) of said female shaft (2) for transmitting torque; at least one rolling member (3) provided between the outer peripheral portion of

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said male shaft (1) and the inner peripheral portion of said female shaft (2) and rolling when said male shaft and said female shaft are relatively moved in the axial direction; a preloading portion (130/134) which includes an elastic member (134) provided adjacent to said rolling member (3) for applying preload on said male shaft (1) and said female shaft (2) through said rolling member (3); wherein said torque transmitting portion (34/35) includes an axial protrusion/spline fitting portions (34) formed on an outer peripheral surface of said male shaft (1) and an axial groove/splines (35) formed on an inner peripheral surface of said female shaft (2) to receive the axial protrusion (34); wherein said preloading portion (130/134) comprises a first axial groove (141) provided on an outer peripheral surface of said male shaft (1) and a second axial groove (142) provided on an inner peripheral surface of said female shaft (2) opposed to said first axial groove (141); said rolling member (3) and said elastic member (134) are provided between said first and second axial grooves (141/142); wherein a plurality of said preloading portions (130/134) are provided between said male shaft (1) and said female shaft (2); a plurality of said torque transmitting portions (34/35) are provided respectively between adjacent preloading portions (130/134); wherein said preloading portions (130/134) are provided at intervals of 120° in a circumferential direction (see Figure 12) and said torque transmitting portions (34/35) are respectively provided between said preloading portions (130/134); wherein said torque transmitting portions (34/35) are provided at respective central portions in the circumferential direction between said preloading portions (130/134, the transmitting portions are centered between the preload portions see Figure 12); wherein said rolling member (3) comprises a spherical

member (roller is a ball); wherein said telescopic shaft is constructed for incorporation in a vehicle steering mechanism (see Figure 1).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duval '993.

Duval discloses all of the claimed subject matter as disclosed above. Duval also discloses that the telescopic shaft is constructed for incorporation in a vehicle steering mechanism (see Figure 1).

Duval does not disclose within the species of Figure 12 that the elastic member is a leaf spring.

Duval teaches that a leaf spring can (224) be used as the elastic member which applies the preload on the male and female members to keep the ball in contact with both the races and the groove.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a leaf spring, as taught by Duval in the species of Figure 20, as the elastic member which applies a preload on the male and female members to keep the ball in contact with both the races and the groove.

7. Claims 23 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duval '993 in view of Brown, USP 4,357,137.

Duval discloses all of the claimed subject matter as disclosed above. Duval also discloses that the telescopic shaft is constructed for incorporation in a vehicle steering mechanism (see Figure 1).

Duval does not disclose the use of a solid lubricant film on one of the shafts.

Brown teaches that a solid self-lubricating plastic can be used increase the physical properties of the shaft (C3/L19-41).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a solid lubricating film in the telescopic assembly of Duval, as taught by Brown, to increase the physical properties (i.e. fatigue resistance) of the shaft.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14, 15, 17, 21, 22, 24, 25, 27, 31 and 32 are rejected on the ground of nonstatutory double patenting over claims 1, 2 and 5 of U. S. Patent No. 7,338,078 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a male and female shaft, structure of the torque transmitting portions (protrusions and mating grooves), a rolling member (spherical body) and the structure of the preloading portions (elastic member/spring and opposed grooves).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES PILKINGTON whose telephone number is

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(571)272-5052. The examiner can normally be reached on Monday-Friday 8:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. P./  
Examiner, Art Unit 3682  
4/10/08

/Richard WL Ridley/  
Supervisory Patent Examiner, Art Unit 3682